

## **ADMINISTRATIVE PANEL DECISION**

Khadi and Village Industries Commission v. puneet agarwal, Hi tech minerals  
Case No. D2022-1202

### **1. The Parties**

The Complainant is Khadi and Village Industries Commission, India, represented by Fidus Law Chambers, India.

The Respondent is puneet agarwal, Hi tech minerals, India.

### **2. The Domain Name and Registrar**

The disputed domain name <praktikpaint.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 7, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 8, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 8, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2022. The Respondent sent informal email communications on April 12, and April 21, 2022.

The Center appointed Vinod K. Agarwal, as the sole panelist in this matter on May 10, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

In the first instance it is clarified that the expression “khadi” is a word of Indian (Hindi) language and means “hand woven cloth”. Similarly, the word “prakritik” is also a word of Indian (Hindi) Language and means “based on nature or natural”.

The Complainant is a statutory body formed in April 1957 by the Government of India under the Act of Parliament, namely, Khadi and Village Industries Commission Act, 1956. As per the Act of Parliament of India the word “khadi” is also a part of the name of the Complainant. The Head Office of the Complainant is in Mumbai, India, and it has six zonal offices in different parts of India. Further, it has offices in 28 states in India for the implementation of its various programs. Ever since its formation in the year 1957, the Complainant has been carrying on work related to implementation of programs for the development of Khadi and other Village Industries in the rural areas in coordination with other agencies. The programs offered by the Complainant are to promote products under one of its trademarks, namely, KHADI. There are about 7 sales outlets directly owned by the Complainant out of 8,050 sales outlets spread across the country all selling authorized/licensed products under the said trademark.

The Complainant is also engaged in the promotion and development of products under the terms “Khadi Prakritik Paint” and “Prakritik Paint Eco-Friendly Cow Dung Paint”. The Complainant officially launched these products on January 12, 2021, via a live-streamed public event on the YouTube channel belonging to the Indian Union Minister for Road Transport and Highways and MSME, as well as a press release of the same date by the same government official. Afterwards, the Complainant filed trademark applications for the wordmark KHADI PRAKRITIK PAINT and two device marks featuring “Prakritik Paint” as the dominant element with “Eco-Friendly Cow Dung Paint” written in smaller script below (hereinafter, referred to as the “PRAKRITIK PAINT device marks”), on February 11, 2022.

The disputed domain name was registered on January 12, 2021, and resolves to a parking page where the disputed domain name is for sale.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that each of the three elements specified in paragraph 4(a) of the Policy are applicable to the present dispute.

In relation to the first element, the Complainant contends that the Complaint is based on its common law rights to the word mark KHADI PRAKRITIK PAINT and the PRAKRITIK PAINT device marks (hereinafter referred to as the “Complainant’s mark” unless otherwise indicated), used in connection with goods offered by the Complainant and its authorized representatives, to which the Complainant holds pending trademark applications. The Complainant contends that its rights to the Complainant’s marks have been upheld by the Delhi High Court in an instance where the opposing party made use of similar branding composed of the “Prakritik Paint” element of the Complainant’s PRAKRITIK PAINT device marks; the High Court ultimately ruling that the opposing party was infringing the Complainant’s rights.

The disputed domain name incorporates the Complainant's common law rights.

The Complainant announced the launch of its above-referenced products on January 12, 2021. Since then, the Complainant has engaged in the continuous use and publicity of the Complainant's marks, engaging in the sale of such trademarked products under the website "www.kviconline.gov.in". By virtue of its adoption and extensive use thereof, the Complainant's marks have become exclusively associated with the Complainant.

The disputed domain name incorporates elements of the Complainant's marks. Furthermore, the generic Top-Level Domain ("gTLD") ".com" does not prevent a finding of confusing similarity between the disputed domain name.

In relation to the second element, the Complainant contends that by virtue of continuous and exclusive use since January 12, 2021, as well as the promotion of the Complainant's marks by the Complainant, the public and members of trade now recognize and associate the goods and services under the Complainant's marks with the Complainant.

The Complainant claims that the Respondent has registered the disputed domain name solely for the purpose of misleading the Complainant's consumers. None of the exemptions provided under paragraph 4(c) of the Policy apply in the present proceeding. The Respondent is in no way related to the Complainant, nor has the Complainant licensed, otherwise permitted or granted to the Respondent an authorization or a right to use the Complainant's marks to register a domain name incorporating said marks. The Respondent is not a licensee or franchisee of the Complainant. The Complainant claims that nobody would use the words "praktik paint" unless seeking to create an impression of an association with the Complainant. Thus, there are no legitimate rights or interests for the Respondent in the disputed domain name.

Regarding the third element, the Complainant contends that the disputed domain name was registered in bad faith and with a primary aim to disrupt the business of the Complainant as well as take advantage of goodwill and reputation associated with the Complainant. The fact that the Respondent has failed show a legitimate *bona fide* use of the disputed domain name, *i.e.* offering of goods/services demonstrates that the Respondent has registered the disputed domain name in bad faith and with *mala fide* intention.

The Complainant contends that the primary aim of the Respondent is to sell or transfer the disputed domain name to the Complainant or any third party. The website to which the disputed domain name resolves states that the disputed domain is for sale. There is even a "make offer" button on the website, which clearly demonstrates that the disputed domain name was registered and used in bad faith for purposes of selling it to the Complainant or another entity in excess of the Respondent's out-of-pocket expenses. Since its registration on January 12, 2021, the Respondent has failed to establish any demonstrable preparation to use or actually use the disputed domain name for any *bona fide* purposes.

The Complainant launched its products under the Complainant's marks on January 12, 2021. The Respondent registered the disputed domain immediately on the day of the launch, purportedly with the purpose to block the disputed domain name from the Complainant. It is therefore extremely unlikely that the Respondent registered the disputed domain name independently without any knowledge of the Complainant's launch the same day.

The Complainant contents that none of the exemptions provided under paragraph 4(c) of the Policy apply in the present proceeding. The Complainant has not authorized, licensed or permitted the Respondent to register or use the disputed domain name.

Therefore, the registration of the disputed domain name by the Respondent is in bad faith and the relevant requirements under the Policy have been met.

## B. Respondent

The Respondent has sent informal email communications in the present proceeding. However, the Respondent has not submitted any substantial evidence or arguments indicating its relation with the disputed domain name or any trademark right, domain name right or contractual right.

Additionally, the Respondent states, and provides a stamped court sheet, that it has filed a legal proceeding against the Complainant in India and has requested the suspension of this proceeding in light of said legal proceeding<sup>1</sup>.

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant relies on common law rights to the Complainant's marks, to which it has a pending trademark applications for both the KHADI PRAKRITIK PAINT word mark and PRAKRITIK PAINT device marks. Further to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1.4, "[a] pending trademark application would not by itself establish trademark rights within the meaning" of the Policy.

However, further to sections 1.3 and 1.7 of the [WIPO Overview 3.0](#), the Panel finds that the Complainant has established rights to the Complainant's marks for purposes of the Policy. In making this finding, the Panel considers the Complainant's general notoriety behind its KHADI mark that is incorporated within the KHADI PRAKRITIK PAINT word mark, the Delhi High Court Ruling in favor of Complainant's rights in the Complainant's marks, the Complainant's extensive publicity of its launch event for the products under the Complainant's marks, the Complainant's launch event sponsored by officials of the Indian government, the Complainant's furnishing of its PRAKRITIK PAINT device marks on banners during the above-referenced publicity event, as well as the broader case context surrounding the Respondent's simultaneous registration of the disputed domain name on the date of the above-referenced publicity event, which reinforces the belief that the Respondent registered the disputed domain name precisely because it knew of the Complainant's rights.

The Panel therefore finds that the disputed domain name incorporates the dominant element of the Complainant's marks. The gTLD, in this case ".com", is typically not considered for purposes of the first element comparison test. See section 1.11 of [WIPO Overview 3.0](#). Accordingly, since "a dominant feature of the [Complainant's marks] is recognizable" in the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant.

Therefore, the Panel finds that the first element is established.

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<sup>1</sup> Pursuant to paragraph 18(a) of the Rules, the Panel exercises its discretion to proceed with this decision.

## **B. Rights or Legitimate Interests**

According to paragraph 4(c) of the Policy, the Respondent may demonstrate its rights to or legitimate interests in the disputed domain name by proving any of the following circumstances:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence in the present proceedings that suggests that the Respondent is or has become commonly known by the disputed domain name, nor has established rights or legitimate interests in the disputed domain name. The name of the Respondent does not resemble the disputed domain name in any manner.

Furthermore, that the Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's marks to register a domain name incorporating them. While the Panel is mindful that the Complainant did not have registered trademark rights in the Complainant's marks at the time Respondent registered the disputed domain name, it is beyond circumstantial and suspicious that Respondent registered the disputed domain name and started to offer the disputed domain name for sale on the exact same day as the Complainant's official launch event for the products under the Complainant's marks. The evidence before the Panel, none of which is contested by Respondent, suggests that Respondent's intent was to capitalize on Complainant's nascent trademark rights in the Complainant's marks.

Based on the present evidence, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the disputed domain name in bad faith;

- (i) Circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) The Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding disputed domain name, provided that it has engaged in a pattern of such conduct; or
- (iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on its web site or location.

The Complainant contends that the disputed domain name was registered or acquired by the Respondent for the

purpose of taking advantage of the Complainant's goodwill and attempting to create a likelihood of confusion with the Complainant's marks. Furthermore, the Complainant contends that the Respondent registered the disputed domain name with the purpose to sell it to the Complainant or any third party. The Panel also notes that the disputed domain name was registered on the same day as the Complainant launched its products under the Complainant's marks. The Panel therefore finds it highly unlikely that the Respondent was not aware of the Complainant's marks when registering the disputed domain name.

The Panel finds that the disputed domain name was registered and used in bad faith. Paragraph 4(a)(iii) of the Policy is satisfied.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <praktikpaint.com> be transferred to the Complainant.

*/Vinod K. Agarwal/*

**Vinod K. Agarwal**

Sole Panelist

Date: June 3, 2022